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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91158827
Party	Defendant Plant Food Systems, Inc. Plant Food Systems, Inc. P.O. Box 775 Zellwood, FL 32798
Correspondence Address	Ralph D. Chabot Ralph D. Chabot 2310 East Ponderosa Drive Suite 4 Camarillo CA U, SA 93010
Submission	Motion to Suspend for Civil Action
Filer's Name	Ralph D. Chabot
Filer's e-mail	rdc@chabotlaw.com
Signature	/rdc/
Date	02/09/2004
Attachments	Motion to Suspend.PDF (16 pages)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

BIAGRO WESTERN SALES, INC.,

Opposer,

vs.

PLANT FOOD SYSTEMS, INC.,

Applicant.

Opposition No.: 91158827

Motion to Suspend
Pending Inter Partes Proceeding

Pursuant to 37 C.F.R. §2.117, Applicant, by its attorney of record, hereby moves to suspend the above-captioned proceeding pending disposition of Civil Action 6:04-CV-44-ORL-18-JGG filed by Applicant against Opposer in the U.S. District Court for the Middle District of Florida. A copy of the Complaint is provided as an Exhibit to this motion.

Applicant has applied for federal registration of its trademark K-PHITE for fungicides (serial no. 78/231,301 in Class 3) and has previously obtained Federal registration for its trademark K-PHITE for fertilizers (Registration No. 2,636,742 in Class 1).

Opposer has filed a Notice of Opposition to application Serial No. 78/231,301, claiming confusion and dilution of its registration for NUTRI-PHITE (Registration No. 1,934,958) which Opposer considers as being famous.

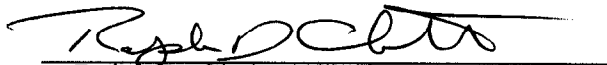
In addition to filing said Opposition, Opposer sent a cease-and-desist letter dated November 13, 2003 (Exhibit A to the attached Complaint) threatening litigation if Applicant's use of K-PHITE was not terminated for both fungicides and fertilizers.

Disposition of the civil action will determine not only whether Applicant is entitled to register K-PHITE in Class 3 but will also determine whether Applicant is entitled to use K-PHITE as a designation for fertilizers and fungicides under the common law as well as determine other issues beyond the scope of this Opposition Proceeding. In the interests of judicial

economy, it is therefore requested that this Opposition Proceeding be suspended pending disposition of Civil Action 6:04-CV-44-ORL-18-JGG.

Respectfully submitted,

Dated: February 9, 2004




Ralph D. Chabot (CA SBN#174513)
Chabot & Associates
2310 East Ponderosa Drive, Suite 4
Camarillo, CA 93010-4747
Tel: (805)388-5028
Fax: (805)388-5596

Attorney for Applicant

Certificate of Service

I hereby certify that a copy of the foregoing **Motion to Suspend Pending Inter Partes Proceeding** was mailed first-class mail, postage prepaid, to Mark Miller, Kimble MacMichael & Upton, 5260 N. Palm Avenue, Suite 221, Fresno, CA 93792-9489, attorneys for Opposer, this 9th day of February 2004.



Ralph D. Chabot
Attorney for Applicant

COPY

IN THE UNITED STATES DISTRICT COURT
MIDDLE DISTRICT OF FLORIDA
ORLANDO DIVISION

PLANT FOOD SYSTEMS, INC.,
a Florida corporation,

Plaintiff,

v.

Case No.: 6:04-CV-44-ORL-18-J66

BIAGRO WESTERN SALES, INC.,
a California corporation,
**BIAGRO WESTERN EASTERN
DIVISION, LLC.,** a Florida limited
liability company, and
MCLEAN AG CHEM, INC.,
a Florida corporation,

Defendant.

U.S. DISTRICT COURT
MIDDLE DISTRICT OF FLORIDA
ORLANDO, FLORIDA

2004 JUN 13 PM 2:52

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COMPLAINT FOR DECLARATORY RELIEF

The Plaintiff, PLANT FOOD SYSTEMS, INC., ("PFS"), hereby sues the Defendants, BIAGRO WESTERN SALES, INC., BIAGRO WESTERN EASTERN DIVISION, LLC., and MCLEAN AG CHEM, INC., (collectively "BIAGRO"), and for its causes of action states:

I. JURISDICTION AND VENUE

1. This is an action for declaratory relief under the Declaratory Judgment Act, 28 U.S.C. § 2201, to determine the scope of PFS' rights under the Lanham Act, 15 U.S.C. § 1119, thus vesting this Court with subject matter jurisdiction under 28 U.S.C. §§ 1331 and 1338.
2. Venue properly lies in this judicial district under 28 U.S.C. §§ 1391(b) and 1400(a).

II. PARTIES

3. PFS is a Florida corporation with its principal place of business located in Zellwood, Florida.
4. BIAGRO WESTERN SALES, INC., is a California corporation with its principal place of business located in Visalia, California.
5. BIAGRO WESTERN EASTERN DIVISION, LLC., is a Florida limited liability company with its principal place of business located in Visalia, California, and subsidiary of BIAGRO WESTERN SALES, INC.
6. MCLEAN AG CHEM, INC., is a Florida corporation with its principal place of business located in Clermont, Florida. MCLEAN AG CHEM, INC. is the managing member of BIAGRO WESTERN EASTERN DIVISION, LLC.

III. COMMON ALLEGATIONS

A. PFS' "K-PHITE" Mark

7. PFS is engaged in the sale of fertilizers and fungicides for agricultural and horticultural uses.
8. PFS is the owner of Registration Number 2,636,742, issued October 15, 2002 by the United States Patent and Trademark Office ("USPTO"), for the mark "K-PHITE" in Class 1 for liquid fertilizers for agricultural and horticultural use.
9. BIAGRO did not file a "Notice of Opposition" with the USPTO to prevent registration of the mark "K-PHITE" in Class 1 as a fertilizer.
10. At the time the USPTO approved for registration the mark "K-PHITE" as a fertilizer in Class 1, the USPTO had previously registered to a third party at least

one other trademark incorporating the suffix word "PHITE"; namely "HOP-PHITE," Registration Number 2,503,708.

11. BIAGRO did not file a "Notice of Opposition" with the USPTO to prevent registration of the mark "HOP-PHITE" in Class 1 as a fertilizer.

12. To date, the USPTO has registered numerous marks that include "PHITE" or phonetic equivalents such as "FIGHT" and "FITE".

13. On March 28, 2003, PFS submitted to the USPTO an application to register "K-PHITE" in Class 3 as a fungicide. This application was assigned Serial Number 78/231,301 and remains pending before the USPTO.

B. BIAGRO's "MAGNA-PHITE" and "NUTRI-PHITE" Marks

14. BIAGRO is engaged in the sale of fertilizers for agricultural and horticultural uses.

15. Based upon information and belief, under the terms of a valid and enforceable settlement contract with Rhone-Poulenc, BIAGRO is contractually precluded from selling fungicide products bearing the marks "MAGNA-PHITE" and "NUTRI-PHITE."

16. BIAGRO owns the mark "NUTRI-PHITE" which was registered by the USPTO in Class 1 as a fertilizer on November 14, 1995, Registration Number 1,934,958.

17. BIAGRO owns the mark "MAGNA-PHITE" which was registered by the USPTO in Class 1 as a fertilizer on July 31, 2001, Registration Number 2,473,307.

18. BIAGRO and PFS are both engaged in the marketing and sale of products to the agricultural industry.

C. BIAGRO'S Litigation Threats and Opposition Proceeding

19. By letter dated November 11, 2003, BIAGRO threatened to sue PFS for trademark infringement and unfair competition if PFS did not immediately cease and desist any and all uses of the "K-PHITE" designation on any agricultural chemical products and expressly abandon its pending application with the USPTO to register "K-PHITE" in Class 3 as a fungicide. (See Exhibit "A").

20. On December 16, 2003, BIAGRO filed with the Trademark Trial and Appeal Board ("TTAB") of the USPTO an "Opposition Proceeding" under 15 U.S.C. § 1063 seeking to prevent the registration of "K-PHITE" in Class 3 as a fungicide. This proceeding has been designated Opposition No. 911158827 by the TTAB. (See Exhibit "B").

IV. COUNT ONE – Declaratory Judgment

21. PFS hereby realleges paragraphs 1 through 20, *supra*.

22. There is a present and actual controversy between PFS and BIAGRO and there is doubt concerning the nature of their legal relations and their respective rights under the Lanham Act, 15 U.S.C. § 1051, *et seq.*

23. BIAGRO's Opposition Proceeding before the TTAB will only determine whether PFS is entitled to registration which would permit PFS to use the "®" with "K-PHITE" in Class 3 for fungicides and any forthcoming TTAB decision is subject to judicial review. Even if refused registration, the TTAB has no authority to preclude PFS from continuing to use "K-PHITE" both as a fertilizer and as a

fungicide as a trademark under the common law. Hence, no matter the outcome of the Opposition Proceeding, the actual controversy and dispute between BIAGRO and PFS will still exist; namely, under the common law whether PFS' use of the mark "K-PHITE" for fertilizers in Class 1 and fungicides in Class 3 is:

- A. likely to cause confusion or to cause mistake or to deceive;
- B. falsely suggest a connection with BIAGRO; or
- C. dilute the distinctive quality of the "NUTRI-PHITE" mark owned by BIAGRO.

24. BIAGRO wrongfully contends that PFS' "K-PHITE" mark is so similar to BIAGRO's "NUTRI-PHITE" and "MAGNA-PHITE" marks as to be likely to cause confusion in the minds of the public and to deceive purchasers, and would also tend to cause confusion as to source or origin. These are matters of import to PFS as they call into question the scope of PFS' right to use its "K-PHITE" mark in commerce in any part of the United States.

25. BIAGRO's filing of the Opposition Proceeding and its threats of litigation are clouding PFS' right to use the "K-PHITE" mark on its fertilizer and fungicide products which is causing PFS actual and irreparable harm.

26. PFS contends that registration and use of the "K-PHITE" mark in Class 3 as a fungicide or its present statutory and common law use of "K-PHITE" as a trademark for fertilizers in Class 1 are not likely to cause confusion, mistake or deception as to source or origin.

27. BIAGRO's contentions are without merit given that numerous marks are registered on the register that include the suffix "phite" or its phonetic equivalent.

28. There is a present need for a declaratory judgment and for supplemental relief to enforce the declaration because:

A. PFS and BIAGRO disagree as to the likelihood of confusion, mistake or deception as to source or origin of PFS' "K-PHITE" fertilizer and fungicide products, dilution of the "NUTRI-PHITE" mark, or the relationship between PFS and BIAGRO; and

B. PFS and BIAGRO are entitled to have their rights and obligations with respect to registration of the "K-PHITE" mark as a fungicide finally declared and established.

29. All conditions precedent to the initiation and maintenance of this action have been performed, have occurred, are excused or have been waived.

30. PFS is entitled to recover its reasonable attorneys' fees and costs from BIAGRO.

WHEREFORE PFS respectfully requests that this Court enter a final judgment in favor of PFS declaring that:

1) pursuant to 28 U.S.C. § 2201, declaring that PFS' "K-PHITE" mark used as a fertilizer in Class 1 or as a fungicide in Class 3 is not likely to cause confusion or to cause mistake or to deceive customers who are wanting to purchase the BIAGRO products "NUTRI-PHITE" or "MAGNA-PHITE";

2) pursuant to 28 U.S.C. § 2201, declaring that PFS' "K-PHITE" mark used as a fertilizer in Class 1 or as a fungicide in Class 3 does not falsely suggest a connection with BIAGRO;

3) pursuant to 28 U.S.C. § 2201, declaring that the "NUTRI-PHITE" mark owned by BIAGRO is not a "famous mark" as that term is used in the Lanham Act, and PFS' "K-PHITE" mark used as a fertilizer in Class 1 or as a fungicide in Class 3 does not dilute the distinctive quality of the "NUTRI-PHITE" mark;

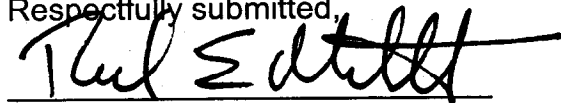
4) pursuant to 15 U.S.C. § 1119, ordering the Commissioner of Patents and Trademarks to dismiss with prejudice BIAGRO's opposition proceeding bearing Opposition No. 911158827 and permit the application bearing serial number 78/231,301 for the registration of PFS' "K-PHITE" mark in Class 3 as a fungicide to issue;

5) awarding PFS its reasonable attorneys' fees and costs;

6) awarding PFS such other relief as is just and equitable.

DATED this 13th day of January, 2004.

Respectfully submitted,



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Florida Bar No.: 0168092
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MATTHEW G. BACKOWSKI
HENRY Y. CHIU

OF COUNSEL
MARY ANN BLUHM
WALTER H. PORR, JR.

November 11, 2003

File # 7560.19

**Certified Mail -
Return Receipt Requested**

Plant Food Systems, Inc.
P.O. Box 775
Zellwood, FL 32798

Re: U.S. Trademark Registration No. 2,473,307 *Magna Phite*
U.S. Trademark Registration No. 1,934,958 *Nutri-Phite*

Dear Sirs:

Please be advised that this office represents Biagro Western Sales, Inc. of Visalia, California ("Biagro"). Biagro is the owner and holder of U.S. Trademark Registration Nos. 1,934,958 and 2,473,307 for the marks *Nutri-Phite®* and *Magna Phite®* for use on agricultural and horticultural fertilizers and chemicals. Copies of these two Registrations are enclosed.

It has come to our attention that Plant Food Systems, Inc. has begun advertising and promoting phosphite fertilizers under the names "MAG-PHITE" and "AG-PHITE." Use of these terms in advertising constitutes trademark infringement of Biagro's *Magna Phite®* and *Nutri-Phite®* trademarks and unfair competition under state and federal law (15 U.S.C. §§ 1114, 1125). Please be advised that your use of these terms because it is likely to cause confusion, mistake and/or deception with respect to the products provided by Biagro. It is also likely to cause confusion as to the origin, sponsorship and/or approval of the products and commercial activities of Biagro.

It has also come to our attention that Plant Food Systems, Inc. is using the name K-PHITE in advertising and promoting a phosphite based fungicide. As with "MAG-PHITE" and "AG-PHITE," use of the term K-PHITE in advertising constitutes trademark infringement of Biagro's *Nutri-Phite®* and *Magna Phite®* family of trademarks and unfair competition under state and federal law (15 U.S.C. §§ 1114, 1125) because this term is likely to cause confusion, mistake and/or deception with respect to the products provided by Biagro.



KIMBLE, MACMICHAEL & UPTON

Plant Food Systems, Inc.
November 11, 2003
Page 2

The purpose of this letter is to provide you with an opportunity to resolve this matter before formal litigation is commenced, in order that you may avoid the following:

1. Payment of all losses sustained by Biagro as a result of your trademark infringement and unfair competition;
2. Treble damages;
3. Entry of an injunction preventing you from continuing to use the "AG-PHITE," "MAG PHITE" and "K-PHITE" designations;
4. All legal attorney's fees and court costs incurred in connection with the prosecution of an action for trademark infringement and unfair competition against you; and
5. Your own legal fees and costs for unsuccessfully defending such an action.

Accordingly, demand is hereby made that you immediately cease and desist any and all use of the "AG-PHITE," "MAG-PHITE" and "K-PHITE" designations on any agricultural chemical products and expressly abandon the trademark application for K-PHITE. Failure to respond within ten (10) days of the date of this letter will leave Biagro with no alternative but to institute formal legal proceedings against Plant Food Systems, Inc.

Sincerely,



Mark D. Miller

/mdm

Enclosures

cc: Biagro Western Sales, Inc.

TTAB

1 MARK D. MILLER 116349
D. TYLER THARPE 120427
2 ROBERT W. BRANCH 154963
KIMBLE, MacMICHAEL & UPTON
3 A Professional Corporation
5260 North Palm, Suite 221
4 Post Office Box 9489
Fresno, California 93792-9489
5 Telephone: (559) 435-5500
Facsimile: (559) 435-1500

12-15-2003
U.S. Patent & TMO/TM Mail Rpt 01 02

6 Attorneys for Plaintiffs
7 BIAGRO WESTERN SALES, INC.

8 Certificate of Mailing

9 I hereby certify that this correspondence, including listed enclosures, is being deposited
10 with the United States Postal Service as First Class Mail, postage prepaid, in an
envelope addressed to: BOX TTAB, FEE, Commissioner for Trademarks, 2900 Crystal
11 Drive, Arlington, Virginia 22202-3514, on December 10, 2003.

12 Signed: Gable A. Alfano
Gable A. Alfano

13 **IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**
14 **BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

15 * * *

17 BIAGRO WESTERN SALES, INC., a
California corporation,
18
19 Plaintiffs,
20 v.
21 PLANT FOOD SYSTEMS, INC., A Florida
corporation,
22 Respondent.

Opposition No. _____

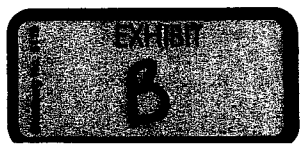
OPPOSITION TO REGISTRATION

Serial No. 78/231,301
Filing Date: March 28, 2003
Mark: K-PHITE

12/16/2003 KGIB 00000052 78231301
01 FC:6402 300.00 OP

25 Opposer Biagro Western Sales, Inc., a California corporation located and doing business
26 at 35801 Road 132, Visalia, California 93292 ("Biagro"), believes that it will be damaged by
27 registration of the mark shown in Serial No. 78/231,301 (K-PHITE), and hereby opposes same.

28 LAW OFFICES
Kimble, MacMichael
& Upton
A PROFESSIONAL CORPORATION
5260 NORTH PALM AVENUE
SUITE 221
P. O. Box 9489
FRESNO, CA 93792-9489



1 Description of Applicant's Application:

2 Filed on March 28, 2003.

3 Published for opposition on November 12, 2003.

4 Mark: K-PHITE in class 005 for fungicide for agricultural use.

5 As grounds of opposition it is alleged that:

6 1. Opposer is the owner of U.S. Trademark Registration No. 1,934,958 for the mark
7 NUTRI-PHITE on agricultural and horticultural fertilizers and chemicals that was registered on
8 the Principal Register on November 14, 1995. Said registration was based on an application filed
9 in the U.S. Patent and Trademark Office on June 24, 1994, which is a date prior to the date of
10 filing of applicant's application. Said registered mark of opposer is valid and subsisting and is
11 conclusive evidence of opposer's exclusive right to use said mark in commerce on ~~the~~ goods
12 specified in said registration. In view of the similarity of the respective marks and ~~the~~ related
13 nature of the goods of the respective parties, it is alleged that applicant's mark so resembles
14 opposer's registered mark, as to be likely to cause confusion or to cause mistake or to deceive.

15 2. Opposer is the owner of U.S. Trademark Registration No. 2,473,307 for the mark
16 MAGNA-PHITE on agricultural and horticultural fertilizers and chemicals that was registered on
17 the Principal Register on July 31, 2001. Said registration was based on an application filed in the
18 U.S. Patent and Trademark Office on March 28, 2000, which is a date prior to the date of filing
19 of applicant's application. Said registered mark of opposer is valid and subsisting and is prima
20 facie evidence of opposer's exclusive right to use said mark in commerce on the goods specified
21 in said registration. In view of the similarity of the respective marks and the related nature of the
22 goods of the respective parties, it is alleged that applicant's mark so resembles opposer's
23 registered mark, as to be likely to cause confusion or to cause mistake or to deceive.

24 3. Opposer since March 30, 1994, has been, and is now, operating a business that
25 promotes the sales of agricultural and horticultural fertilizers and chemicals under the
26 designation NUTRI-PHITE which, in addition to being used on the labels for such products, is
27 applied to sales literature, clothing such as jackets and shirts, caps, mugs, briefcases, and the like.
28 Said use has been valid and continuous since said date of first use, and the relevant class of the
public has come to associate opposer with said designation. In view of the similarity of

1 applicant's designation with opposer's designation, and in view of the related nature of the uses
2 thereof, it is alleged that applicant's designation consists of and comprises matter that may
3 falsely suggest a connection with opposer.

4 4. Opposer incorporates paragraphs 1 and 3 above as if fully set forth herein. In view
5 of the similarity of applicant's designation with opposer's mark, and in view of the related nature
6 of the uses thereof, it is alleged that applicant's designation would dilute the distinctive qualify
7 of opposer's famous NUTRI-PHITE mark.

8 5. Respondent Plant Food Systems, Inc. has already used the federal registration
9 symbol ® in connection with the designation K-PHITE on fungicide products, as set forth in the
10 attached advertisement taken from respondent's internet web site. On information and belief,
11 Respondent's use of the federal registration symbol ® is an intentional and fraudulent misuse
12 thereof, since no registration for the K-PHITE designation on fungicide products has yet
13 occurred, and registration of applicant's K-PHITE designation should therefore be refused.

14 WHEREFORE, opposer requests that registration be refused for application serial
15 number 78/231,301 for the designation K-PHITE.

16 A duplicate copy of this Opposition and the filing fee of \$300 are enclosed pursuant to 37
17 C.F.R. § 2.6(a)(17).

18
19 Dated: December 10, 2003

Respectfully Submitted,

KIMBLE, MacMICHAEL & UPTON
A Professional Corporation

20
21
22 By Mark D. Miller
MARK D. MILLER

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27 Attorneys for Opposer
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KPHITE®

SYSTEMIC FUNGICIDE

- * Controls Phytophthora, Pythium and 11 other diseases, on citrus, fruit crops, vegetables, and field crops
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- * Activates the plants auto immune systems and defense mechanisms to ward off further pathogen attack
- * Economical, low cost per acre to use
- * Low phytotoxicity, single salt of potassium phosphite formulation
- * University tested, proven formulation for over 12 years
- * Compatible with most agricultural chemicals and foliar fertilizers
- * Available exclusively from Plant Food System's distributors

FOLIAR

Plant Food
systems
INC

Plant Food Systems Inc.

Pcst Office Box 775

Zellwood, Florida, 32798

1-800-343-7775 * 1-407-889-7755

Email: plantfoodsystems@att.net

K-Phite® is a registered trademark of PFS